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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,299

08/31/2006

Susumu Noda

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EXAMINER

KIANNI, KAVEH C

ART UNIT

PAPER NUMBER

2883

MAIL DATE

DELIVERY MODE

02/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,299	Applicant(s) NODA ET AL.	
	Examiner Kianni C. Kaveh	Art Unit 2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/31/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election with traverse of claims 1, 4-5 in a paper submitted on 11/16/07 is acknowledged. The traversal is on the ground(s) that search and the examination of the entire application can be made without serious burden. This is not found persuasive because each of the group species as was specified in the previous office action contains limitations that are not found in other group species that would require a different search than that of other group inventions and because each of the above species defining an invention that is distinct from that of the other and requiring a different search. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is ambiguous, since the limitations 'a two-dimensional photonic crystal having a slab-shaped body in which modified refractive index areas which have the same shape and whose refractive index differs from that of the body are cyclically arranged, which is characterized in that' is indefinite since first there is not connection between the 'refractive index areas' and the 'slab-shaped body', secondly, 'areas' are plural and while 'whose reflective index differs' is cited for singular and it may

rather refers to the body? and, similarly, is not clear whether 'characterized in that' is referring to the 'body' or the 'areas'. Appropriate corrections are required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsuya (JPP 2002-084037, cited/provided by the applicant as prior art 1449).

Tatsuya teaches a two-dimensional photonic crystal ,(see at least figures 1-9) having a slab-shaped body in which modified refractive index areas which have the same shape and whose refractive index differs from that of the body ,(see at least fig, 1-3, also at least parag. 0018, 0031), are cyclically arranged, which is characterized in that a plane shape of each modified refractive index area is a polygon (see at least fig, 1-3, also at

least parag. 0018, 0031); which is characterized in that the corners are removed along an arc ,(see at least fig, 1-3); which is characterized in that: the modified refractive index areas are arranged in a triangular lattice pattern; the polygon is an equilateral triangle ,(see at least fig, 1-3).

However, Tatsuya does not specifically state that the above polygon corners are removed, refractive index of the body is within a range from 3.15 to 3.55; and a radius r_a of the arc satisfies the equation stated in claim 1. Although the limitation 'corners are removed' is a functional language and no patentable weight is given, nevertheless, Tatsuya states that etching process is carried out for forming the photonic crystal (see 0045), and that different refractive indices were used in the process (at least 0018), and that the diameter of the hole/arc is controllable by extending etching (see 0040). Thus, it would have been obvious to a person of ordinary skill in the art when the invention was made to mere as a matter of design configuration to use different parameters for making the suggested photonic crystal since such modifications would provide comparatively simple, and controllability or repeatability process of making the photonic crystal (see 0005), and since it is been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)

Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherr et al. (US 5711200).

Scherr teaches a two-dimensional photonic crystal ,(see at least figures 1-2 and 19-21)) also figures having a slab-shaped body in which modified refractive index areas which have the same shape and whose refractive index differs from that of the body are cyclically arranged, which is characterized in that a plane shape of each modified refractive index area is a polygon; which is characterized in that the corners are removed along an arc which is characterized in that: the modified refractive index areas are arranged in a triangular lattice pattern; the polygon is an equilateral triangle ,(see fig, 1-21 and at least, abstract and summary).

However, Scherr does not specifically state that the above polygon corners are removed, refractive index of the body is within a range from 3.15 to 3.55; and a radius r_a of the arc satisfies the equation stated in claim 1. Although the limitation 'corners are removed' is a functional language and no patentable weight is given, nevertheless, it would have been obvious to a person of ordinary skill in the art when the invention was made to mere as a matter of design configuration to use different parameters for making the suggested photonic crystal since such modifications would provide comparatively simple, and controllability or repeatability process of making the photonic crystal (see 0005), and since it is been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. and since it has been held that

discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)

Citation of Relevant Prior Art

Prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In accordance with MPEP 707.05 the following references are pertinent in rejection of this application since they provide substantially the same information disclosure as this patent does. These references are:

US 20050249470 A1

US 20040156610 A1

US 20060010921 A1

US 20060133763 A1

US 20070163301 A1

US 20030059185 A1

US 6990282 B2

US 20070230885 A1

US 20040091224 A1

US 20030174940 A1

US 6901194 B2

US 6804446 B1

US 20050226561 A1

US 6711200 B1

US 20060202125 A1

These references are cited herein to show the relevance of the apparatus/methods taught within these references as prior art.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kianni C. Kaveh whose telephone number is 571-272-2417. The examiner can normally be reached on 9:30-19:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

K. Cyrus Kianni

/Kianni C Kaveh/

Primary Examiner, Art Unit 2883
